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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,579	07/13/2001	Koichi Kamijo	9319S-000246	2348
27572	7590	01/30/2004	EXAMINER	
HARNESS, DICKEY & PIERCE, P.L.C. P.O. BOX 828 BLOOMFIELD HILLS, MI 48303			RUDE, TIMOTHY L	
			ART UNIT	PAPER NUMBER
			2871	

DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/904,579	KAMIJO, KOICHI	
	<b>Examiner</b>	<b>Art Unit</b>	
	Timothy L Rude	2871	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 31 October 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) 25-55 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-24 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 13 July 2001 is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>20010713</u> . | 6) <input type="checkbox"/> Other: _____                                     |

## DETAILED ACTION

### ***Claims***

1. Claim 23 is amended.

### ***Election/Restrictions***

2. Applicant's election without traverse of Group I (claims 1-24) in Paper No. 20031031 is acknowledged. Applicant's arguments are persuasive regarding species within Group I. Examiner has examined all Group I claims.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-24 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The invention comprises an insulating film between a color filter and a transparent electrode, wherein a combination of materials disclosed as inventive in there resistance to alkaline solution ( $Ta_2O_5$ ,  $ZrO_2$ , Specification pages 1-4, especially [0012] and the required index of refraction higher than that of  $SiO_2$  (1.6-2.0, Specification page 7, [0022]) are critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527

F.2d 1229, 188 USPQ 356 (CCPA 1976). It is respectfully pointed out that every base claim must contain at least all essential subject matter. Claims may not be so broad as to fail to claim the fundamental invention. In this case, all claims must include enough limitations to comprise an insulating film enabled to solve the problems described in the related art (Specification, page 1-3) per Specification, page 3, [0009].

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Hironobu et al (Hironobu) Japanese Patent Abstracts publication 06-201912 provided by Applicant.

As to claims 1 and 18, Hironobu discloses a liquid crystal device comprising: a first substrate; a second substrate disposed so as to oppose the first substrate (inherent, Title); a color layer, 2, provided on the first substrate; an insulating film, 3, provided on the color layer and comprising ZrO<sub>2</sub>, as a primary component; and a conductive film, 4, having a property of transmitting light provided on the insulating film (required or color filters would not work).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hironobu in view of Yamazaki et al (Yamazaki) UA Patent Application Publication 2001/0013912 A1.

As to claim 9, Hironobu discloses the device above.

Hironobu does not explicitly disclose the use of Ta<sub>2</sub>O<sub>5</sub> as a primary component.

Yamazaki teaches (page 3, [0056]) the use of Ta<sub>2</sub>O<sub>5</sub> as an art recognized material equivalent to ZrO<sub>2</sub> for purposes of providing a high index of refraction suitable for use in a liquid crystal display.

Yamazaki is evidence that ordinary workers in the art of liquid crystals would find the reason, suggestion, or motivation to add Ta<sub>2</sub>O<sub>5</sub> as a primary component as an art recognized equivalent material to provide the needed higher index of refraction.

Therefore, it would have been obvious to one having ordinary skill in the art of liquid crystals at the time the invention was made to modify the LCD of Hironobu with the art recognized equivalent material, Ta<sub>2</sub>O<sub>5</sub>, to provide the needed higher index of refraction.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy L Rude whose telephone number is (571) 272-2301. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert H Kim can be reached on (703) 305-3492. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4900.



Timothy L. Rude  
Examiner  
Art Unit 2871

tlr



ROBERT H. KIM  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800